



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,363	01/18/2002	Dipankar Gupta	B-3592DIV 619037-4	4193

7590 12/17/2003

LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036

EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,363

Applicant(s)

GUPTA, DIPANKAR

Examiner

Firmin Backer

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7,10-13,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7,10-13,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Request for Reconsideration

This is in response to a request for reconsideration file October 3rd, 2003. Claims 2-7, 10-13, 17 and 18 are being reconsidered in this action.

Response to Arguments

1. Applicant's arguments with respect to claims 2-7, 10-13, 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7, 10-13, 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al (U.S. PG Pub 2001/0001876) in view of Hartrick et al (U.S. Patent No. 5,532,920)
4. As per claims 2 and 18, Morgan et al teach a cryptographic method of using a protocol involving the consumer, the owner, a document source and a mediator, wherein the source requires knowledge of a key in which the document is encrypted in order to provide the document, the key comprising a first portion, a second portion, a third portion, and a fourth portion, the protocol comprising the following sequential the consumer requests a specified

Art Unit: 3621

document the owner provides the source with the first and third portions of the key and provides, a mediator with the fourth portion of the key, which can combine with the third portion of the key to generate a complete key and either, the owner provides the source with the second portion of the key and the first portion of the key is combined with the second portion of the key to generate a complete key; or the owner does not provide the source with the second key portion, and the third key portion is combined with the fourth key portion to generate a complete key (*see, abstract, paragraph 0022, 0023, 0047, 0070, 0087*). Morgan et al fail to teach an inventive concept of enabling a consumer to obtain a document from an owner upon making a payment, and the consumer provides the owner with the payment. However, Hartrick et al teach an inventive concept of enabling a consumer to obtain a document from an owner upon making a payment, and the consumer provides the owner with the payment (*see abstract, column 4 lines 40-44, 5 lines 14-67*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Morgan et al to include Hartrick's inventive concept of enabling a consumer to obtain a document from an owner upon making a payment, and the consumer provides the owner with the payment because this would have provided an improved means to enforce the payment of royalties to publishers and authors of softcopy books, when a reader desires to make a copy of a portion or all of the book

5. As per claim 3, Morgan et al teach a cryptographic method wherein first and third portion are different (*see, abstract, paragraph 0022, 0023, 0047, 0070, 0087*).

Art Unit: 3621

6. As per claim 4, Morgan et al fail to teach a cryptographic method arranged for enabling the consumer to receive a plurality of such documents, wherein the first and second portions are different for each document. Hartrick et al teach a cryptographic method arranged for enabling the consumer to receive a plurality of such documents, wherein the first and second portions are different for each document (*see (see column 15 lines 4-16 lines 29)*).

7. As per claim 5, Morgan et al teach a cryptographic method wherein the mediator is involved in the protocol only in the event of a dispute between the owner and the consumer (*see, abstract, paragraph 0022, 0023, 0047, 0070, 0087*).

8. As per claim 6, Morgan et al fail to teach a cryptographic method wherein the document source comprises a printer. However, Hartrick et al teach a cryptographic method wherein the document source comprises a printer (*see column 15 lines 4-16 lines 29*).

9. As per claim 7, Morgan et al teach a printer including a memory for storing a first key portion and a third key portion, an element for receiving a second key portion or a fourth key portion; and an element for decrypting an encrypted document transmitted thereto in accordance with an encryption key defined by the first and the second key portions or the third and the fourth key portions (*see, abstract, paragraph 0022, 0023, 0047, 0070, 0087*). Morgan et al fail to teach an inventive concept of enabling a consumer to obtain a document from an owner upon making a payment, and the consumer provides the owner with the payment. However, Hartrick et al teach an inventive concept of enabling a consumer to obtain a document

Art Unit: 3621

from an owner upon making a payment, and the consumer provides the owner with the payment (*see abstract, column 4 lines 40-44, 5 lines 14-67*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Morgan et al to include Hartrick's inventive concept of enabling a consumer to obtain a document from an owner upon making a payment, and the consumer provides the owner with the payment because this would have provided an improved means to enforce the payment of royalties to publishers and authors of softcopy books, when a reader desires to make a copy of a portion or all of the book

10. As per claim 10, Morgan fail to teach a printer arranged to print a number of copies of a the document in each of a plurality of formats. However, Hartrick et al teach printer arranged to print a number of copies of the document in each of a plurality of formats (*see column 15 lines 4-16 lines 29*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Morgan et al's concept to include printer arranged to print a number of copies of a the document in each of a plurality of formats because this would have provide the user with different printing options.

11. As per claim 11, Hartrick et al teach a printer arranged to print only one copy of a the document in a first format and an unlimited number of copies of the document in a second format (*see column 15 lines 4-16 lines 29*)

Art Unit: 3621

12. As per claim 12, Hartrick et al teach a printer wherein the formats comprise different resolutions (*see column 15 lines 4-16 lines 29*)

13. As per claim 13, Hartrick et al teach a printer wherein the formats comprise monochrome and color images (*see column 15 lines 4-16 lines 29*)

14. As per claim 17, Morgan et al teach a printer wherein if the consumer provides the owner with the payment, but the owner does not provide the consumer with the second key portion, then the mediator provides the consumer with the fourth key portion (*see, abstract, paragraph 0022, 0023, 0047, 0070, 0087*).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

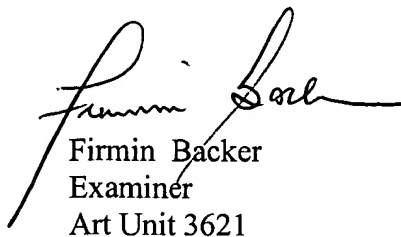
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Application/Control Number: 10/052,363

Page 7

Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer
Examiner
Art Unit 3621

December 7, 2003